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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,965	07/14/2000	Sergey Magnitskii	109289.00146	6517

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EXAMINER	
HUBER, PAUL W	

ART UNIT	PAPER NUMBER
2653	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/616,965	MAGNITSKII ET AL	
	Examiner	Art Unit	
	Paul Huber	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) *27-51* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12,14,15 and 22-25* is/are rejected.

7)☒ Claim(s) *11,13,16-21 and 26* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02282001, 04122001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Invention I, claims 1-26, in the reply filed on July 30, 2004 is acknowledged. The traversal is on the ground(s) that search and examination of the entire application could be made without serious burden. This is not found persuasive because the claims were directed to four distinct inventions which respectively have acquired a separate status in the art as shown by their different classifications. If the examiner were required to search and examine the entire application, the examiner would be led into four different directions during the search thereby posing a serous burden upon the examination process. Therefore, the restriction requirement is maintained.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 10, 12, 14, 15, & 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Glushko et al. (USP-6,009,065).

Regarding claims 1-3 & 22, Glushko et al. discloses a multilayer fluorescent information-carrying optical disc (multilayer disk); a source of reading radiation (CW laser diode); means for focusing the reading radiation into a micro-spot on the multilayer disc (objective lens); means for spatially separating the reading radiation from information-carrying radiation (dichroic filter); and means for detecting an availability of bit information in the micro-spot (four-part photodiode). See figures 1 & 2. See also, col. 4, lines 2-30, and col. 5, lines 8-11.

Regarding claims 10, 12, 14, 15, Glushko et al. further discloses the claimed light controlling element for increasing an amount of the information carrying radiation which reaches the detector, which reads on either the z-axis servo mechanism for focus error control of the objective lens with respect to the illuminated layer or the steering mirror for tracking error control of the light beam. See col. 10, line 50, through col. 11, line 25.

Claims 1-3, 10, & 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Chikuma (USP-4,927,681).

Regarding claims 1-3 & 22, Chikuma discloses a multilayer fluorescent information-carrying optical disc 10 (see col. 2, lines 25-46); a source 21 of reading radiation; means 24 for focusing the reading radiation into a micro-spot on the multilayer disc; means 26 for spatially separating the reading radiation from information-carrying radiation; and means 29 for detecting an availability of bit information in the micro-spot.

Regarding claim 10, Chikuma further discloses the claimed light controlling element for increasing an amount of the information carrying radiation which reaches the detector, which reads on at least a tracking actuator for tracking error control of the objective lens. See col. 3, lines 38-50.

Regarding claims 23-25, Chikuma further discloses that the claimed detector includes a first detector 27 for detecting the information-carrying radiation when the information-carrying radiation has a wavelength equal to a wavelength of the reading radiation, and a second detector 29 for detecting the information-carrying radiation when the information carrying radiation has a wavelength different from the wavelength of the reading radiation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glushko et al., as applied to claim 1 above, in further view of Official Notice.

Glushko et al. discloses the invention as claimed, but fails to specifically teach that the means for spatially separating the reading radiation from the information-carrying radiation includes either a smectic liquid crystal, a liquid crystal Notch filter tuned over a spectrum, or an electrically controlled polarization filter of a Pockels cell type. However, it is manifestly well known in the art of spectrum filters that either one of a smectic liquid crystal, a liquid crystal Notch filter tuned over a spectrum, or an electrically controlled polarization filter of a Pockels cell type can be used to spatially separating light having a particular wavelength from a radiation beam, in the same field of endeavor, for the purpose of detecting characteristics of the separated light, and Official Notice is hereby taken.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Glushko et al. such that either a smectic liquid crystal, a liquid crystal Notch filter tuned over a spectrum, or an electrically controlled polarization filter of a Pockels cell type is used as the means for spatially separating the reading radiation from the information-carrying radiation as claimed and as well known in the art. A practitioner in the art would have been motivated to do this for the purpose of more accurately detecting the information-carrying radiation using the filter which best meets the design requirements of the invention.

Relative to the doctrine of Official Notice, see In re Fox, 176 U.S.P.Q. 340 at 341 (CCPA-1973).

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chikuma, as applied to claim 1 above, in further view of Official Notice.

Chikuma discloses the invention as claimed, but fails to specifically teach that the means for spatially separating the reading radiation from the information-carrying radiation includes either a smectic liquid crystal, a liquid crystal Notch filter tuned over a spectrum, or an electrically controlled polarization filter of a Pockels cell type. However, it is manifestly well known in the art of spectrum filters that either one of a smectic liquid crystal, a liquid crystal Notch filter tuned over a spectrum, or an electrically controlled polarization filter of a Pockels cell type can be used to spatially separating light having a particular wavelength from a radiation beam, in the same field of endeavor, for the purpose of detecting characteristics of the separated light, and Official Notice is hereby taken.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chikuma such that either a smectic liquid crystal, a liquid crystal Notch filter tuned over a

spectrum, or an electrically controlled polarization filter of a Pockels cell type is used as the means for spatially separating the reading radiation from the information-carrying radiation as claimed and as well known in the art. A practitioner in the art would have been motivated to do this for the purpose of more accurately detecting the information-carrying radiation using the filter which best meets the design requirements of the invention.

Relative to the doctrine of Official Notice, see In re Fox, 176 U.S.P.Q. 340 at 341 (CCPA-1973).

Claims 11, 13, 16-21, & 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 703-308-1549.

Paul Huber
Primary Examiner
Art Unit 2653

pwh
September 2, 2004